

Appl. No. : **10/616,102**
Filed : **July 9, 2003**

REMARKS

Claims 1-21 remain pending in the above-identified application. In response to the Office Action mailed March 31, 2005, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the following comments.

Priority

Applicants cordially acknowledge the Examiner's confirmation of the claim for foreign priority for the above-captioned application. Applicants will submit shortly a certified copy of German Application No. 29903766.5, as required by 35 U.S.C. § 119(b).

Information Disclosure Statement

The Examiner stated that the Information Disclosure Statement filed 8/25/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in the English Language.

Applicants herewith submit a Supplemental IDS with further information on the non-English language references submitted in the IDS filed 8/25/03.

Specification

The Examiner objected to the specification for referring to the claims in the specification. Applicants have amended paragraph [0001] to remove reference to the claims. Applicants previously amended paragraph [0006] in a preliminary amendment filed July 8, 2003 to remove reference to claims in that paragraph. Accordingly, Applicants respectfully request the withdrawal of this objection.

The Examiner also objected to the specification as failing to provide proper antecedent basis for the following claimed subject matter: the limitations of the "previously-determined distance" being between "about 26.4 mm and about 37.4 mm" or "about 32 mm" or between "about 30.45 mm and about 33.35 mm." The Examiner notes none of these were found in the specification.

Applicants respectfully submit that the non-limiting embodiments described in at least paragraphs [0008] and [0009] provide adequate support for the claimed subject matter in Claims 13-15. Paragraph [0008] discloses that "the distance separating one or more pegs on the femoral slideway from its dorsal sliding surface is smaller by 5-15%, in particular by about 10% than the corresponding distance by which the bores in the femur-size template for positioning the pegs are

Appl. No. : **10/616,102**
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separated from the contact surface that is to be apposed to the dorsal condyle surfaces of the femur.” In other words, the distance between the bores and the contact surface of the femur-size template is 5-15% longer, and in particular about 10% longer, than the distance between the pegs and the dorsal sliding surfaces of the femoral slideway. Paragraph [0009] discloses that the distance “between the dorsal sliding surfaces and the one or more pegs . . . is preferably in the range between 24 and 34 mm, and in particular 29 mm.”

As is readily ascertainable, a distance 10% longer than 24 mm is 26.4 mm. Likewise, a distance 10% longer than 34 mm is 37.4 mm. Accordingly, Applicants respectfully submit that the claimed subject matter in Claim 13 is fully supported by the specification. Similarly, a distance 10% longer than 29 mm is “about 32 mm,” as recited in Claim 14. Accordingly, Applicants respectfully submit that the Claimed subject matter in Claim 14 is fully supported by the specification. Likewise, a distance 5% longer than 29 mm is 30.45 mm, and a distance 15% longer than 29 mm is 33.35 mm. Accordingly, Applicants respectfully submit that the Claimed subject matter of Claim 15 is fully supported by the specification. Accordingly, Applicants respectfully request the withdrawal of this objection.

Rejection of Claims Under 35 USC § 112

Claims 13 and 14 stand rejected under 35 USC § 112, ¶1, as failing to comply with the written description requirement. The Examiner asserts that the limitation in Claim 13 that the “previously-determined distance is between about 26.4 mm and about 37.4 mm” is not supported in the specification.

As discussed above, Applicants respectfully submit that the non-limiting embodiments described in at least paragraphs [0008] and [0009] provide adequate support for the claimed subject matter in Claims 13-14. Accordingly, Applicants respectfully request the withdrawal of this rejection.

Rejection of the Claims Under 35 USC § 102

Claims 1, 2, 5, 6, 16, 18, and 19 stand rejected under 35 USC § 102(b) as being anticipated by D’Antonio (U.S. Patent No. 5,810,831). Applicants respectfully traverse these rejections.

D’Antonio discloses a femoral sizing guide having a sizing guide block 22 that can be positioned adjacent a distal end 16 of a femur 10, from which a distal portion 14 has been

removed. See '831 patent at Col. 4, lines 1-10. The guide also has locator feet 26 for engaging the posterior condyles 30 to assist in the location of a femoral cutting guide of suitable size. See '831 patent at Col. 4, lines 18-42; Figure 1. The guide block 22 has drill guide openings 60 to guide a drill 62, "thereby assuring the appropriate subsequent location of the femoral cutting guide on the distal femur." '831 patent at Col. 4, lines 57-62. The locator feet 26 can be chosen from a variety of sizes to "space the openings 60 in the sizing guide block 22, in the anterior/posterior direction, by a corresponding selected amount." '831 patent at Col. 5, lines 12-35.

D'Antonio does not disclose, teach or suggest, among other limitations, "providing a femoral slideway having at least one peg adapted for insertion into a hole in the femur," as recited in Claim 1. Contrary to the Examiner's assertion, the holes 18 shown in Figure 2 are not disclosed as receiving pegs located on a slideway, but rather, are for locating a femoral cutting guide.

Additionally, D'Antonio does not disclose locating a point at a predetermined distance from a plane tangent to the dorsal most points of the medial condyles of the femur, drilling a hole at said point, and selecting a slideway having a dimension defined by a perpendicular distance between a longitudinal axis of a peg extending from the slideway and a plane tangent to a dorsal sliding surface furthest away from the peg, wherein the predetermined distance is larger than said dimension, as recited in Claim 1. Figure 4 of Applicant's specification illustrates one non-limiting embodiment, reproduced below, wherein a femur-size template is used to locate the predetermined distance e from a peg-hole and condyles of an unresected femoral bone.

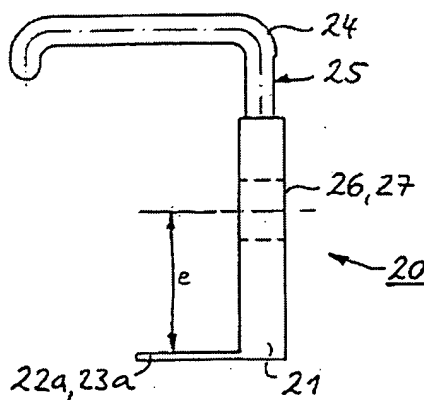
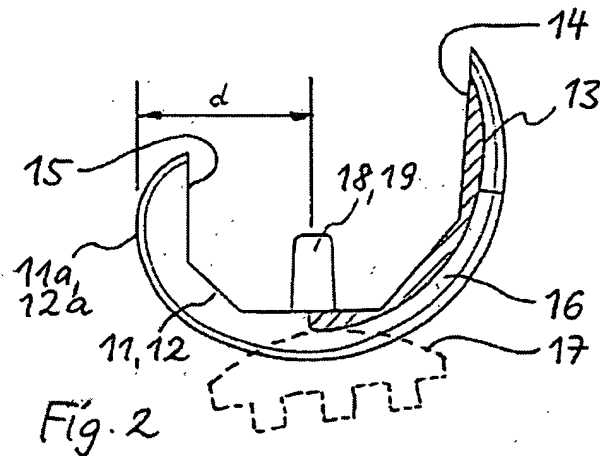


Fig. 4

Once the peg-hole is drilled based on the location determined by the femur-size template, a slideway, such as shown in Figure 2, is selected, which has a distance d defined between the outermost posterior points on the distal sliding surfaces 11a, 12a and the long axis of the pegs 18, 19.



This slideway is selected such that the distance e is greater than the distance d , indicating that more bone has been resected dorsally on the femur than will be replaced by the thickness of the dorsal parts of the condyle shells, as shown in Figure 5b below. However, because the peg-hole location was predetermined by use of the femur-size template, the slideway's position is also predetermined relative to the original, unresected femur.

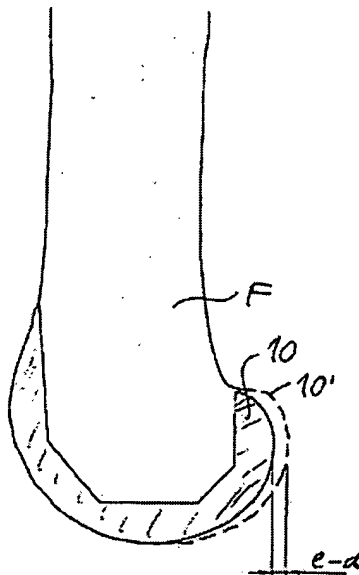


Fig. 56

D'Antonio fails to teach or suggest the unique features described above. In particular, the passage cited by the Examiner at Col. 1, lines 53-64 in the D'Antonio specification at most teaches varying the amount of bone removed from a particular posterior condyle, but does not teach or suggest removing more bone than is replaced by the slideway, with the slideway's position based on a predetermined distance relative to the original, unresected femur.

For the reasons described above, Applicants respectfully submit that Claim 1 is allowable over D'Antonio. Claims 2, 5, and 6 depend from Claim 1 and are therefore likewise allowable over D'Antonio for at least the same reasons as Claim 1, and because these claims recite a unique combination of features not taught or suggested by the cited art.

D'Antonio also does not disclose, teach or suggest, among other things, "providing a slideway comprising two convexly curved condyle shells rigidly connected to one another anteriorly by a patellar shield," the slideway having on an inner surface at least one peg, as recited in Claim 16. Nor does D'Antonio disclose "providing at least one hole in said femur to receive the at least one peg of the slideway and to secure and locate said slideway on said femur," as recited in Claim 16. Furthermore, as discussed above, D'Antonio fails to teach or suggest resecting more bone material from a dorsal side of the femur than is replaced by the slideway, in combination with the other features recited by Claim 16. Accordingly, Applicants respectfully submit that Claim 16 is allowable over D'Antonio. Claims 18 and 19 depend from Claim 16 and

Appl. No. : **10/616,102**
Filed : **July 9, 2003**

are therefore likewise allowable over D'Antonio for at least the same reasons as Claim 16, and because these claims recite a unique combination of features not taught or suggested by the cited art.

Rejection of the Claims Under 35 USC § 103

Claims 3, 4, 7, 9-15, 17, 20, and 21 stand rejected under 35 USC § 103(a) as being unpatentable over D'Antonio. Claim 8 stands rejected under 35 USC § 103(a) as being unpatentable over D'Antonio in view of Colleran et al. (U.S. Patent No. 5,776,201). Applicants respectfully traverse these rejections.

As discussed above, Applicants respectfully submit that Claim 1 is allowable over D'Antonio because D'Antonio does not disclose, teach or suggest the limitations recited by Claim 1. Claims 3, 4, 7 and 8 depend from Claim 1 and are therefore also allowable over D'Antonio, alone or in combination with the cited references, not only because they depend from an allowable base claim, but also because each of these claims recites a unique combination of features not taught in the cited art.

With respect to Claim 9, Applicants respectfully submit that D'Antonio does not disclose, teach or suggest, among other limitations, that a "previously-determined distance is about 5 to 15% larger than a distance between a peg and a dorsal sliding surface of the femoral slideway to be implanted on the femur bone." As noted above, D'Antonio does not disclose, teach or suggest a slideway having a peg and a dorsal sliding surface. Nor does D'Antonio disclose, teach or suggest "implanting the slideway on the femur by inserting the peg into the hole," as recited in Claim 9. Moreover, as discussed above, D'Antonio fails to teach or suggest removing more bone material from a dorsal side of the femur than will be replaced by the slideway, with the slideway implanted by inserting a peg on the slideway into a hole, the hole's location being at a previously-determined distance from a dorsal-most point of a condyle of a femur. Without D'Antonio teaching these desired features, it would not have been merely a matter of design choice for the previously-determined distance to be about 5 to 15% larger than a distance between a peg and a dorsal sliding surface of the femoral slideway. Accordingly, Applicants respectfully submit that Claim 9 is patentable over D'Antonio, alone or in combination with the cited references. Claims 10-15 depend from Claim 9 and are therefore likewise patentable over

Appl. No. : 10/616,102
Filed : July 9, 2003

D'Antonio, not only because they depend from an allowable base claim, but also because each of these claims recites a unique combination of features not taught in the cited art.

Additionally, as discussed above, Applicants respectfully submit that Claim 16 is allowable over D'Antonio. Claims 17, 20, and 21 depend from Claim 16 and are therefore also allowable over D'Antonio, alone or in combination with the cited references, not only because they depend from an allowable base claim, but also because each of these claims recites a unique combination of features not taught in the cited art.

Applicants have amended Claims 1, 9 and 12 to improve the readability of these claims, and not for reasons related to the patentability of these claims.

CONCLUSION

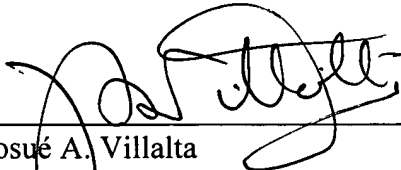
The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/30/05

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